



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,107	04/08/2004	Boris Mayer	30691/DP011	8993

4743 7590 04/25/2007
MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER

BANGACHON, WILLIAM L.

ART UNIT	PAPER NUMBER
----------	--------------

2612

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/821,107

Applicant(s)

MAYER ET AL.

Examiner

William L. Bangachon

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/13/2007 has been entered.

Response to Arguments

2. Applicant's arguments, see Remarks, filed 4/13/2007, with respect to the rejection(s) of claim(s) 1-3 under Kakuta have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the patents issued to Booth et al and Gokcebay et al set forth in this Office action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2612

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2612

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,879,243 {hereinafter 'Booth et al'}.

With regards to claim 1, Booth et al teaches of an electronically controlled locker system (ECL 20) comprising:

- (a) at least two operating units, in the form of LCU 26, shown in Figure 1;
- (b) a plurality of electronic lockers 30, several of which are associated with the LCU 26 {see Booth et al, column 5, lines 35-51+; column 6, lines 40-46};
- (c) a central control unit, in the form of a SAC 22 or SCU 24, for controlling the at least two operating unit 26, the central control unit 22 or 24 comprising an interface, such as a administration software and database, for flexibly associating the lockers 30 with the operating units 26, thereby associating the control means of each operating unit, in the form of a locker control circuitry L56 shown in Figure 11 {see Booth et al, paragraph-bridging columns 5 and 6+}, for controlling the opening and/or closing of the lockers to a different group of lockers {see Booth et al, paragraph-bridging columns 9 and 10+}.

The ECLS 20 of Booth et al can be easily adapted for use in any environment such as fitness clubs, employee lockers, workplaces, airports, resorts, shopping malls, etc {see Booth et al, column 3, lines 29-34}. As such, the lockers can be associated with parcel boxes. This meets the electronic parcel box system as claimed.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,879,243 {Booth et al}.

In claim 2, Booth et al states, the SCU 24 and LCU 26 are in constant communication so that if the connection between the two is severed, system function can continue" {see Booth et al, column 9, lines 5-7}, but, does not disclose "the parcel boxes associated with a malfunctioning operating unit are associated with another operating unit". However, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, that when an operating unit 26 malfunctions in Booth et al, then lockers 30 should be associated with functioning operating units, which is done by either manually repairing the malfunctioning unit or manually replacing it with an operating unit that is functioning properly.

9. Claim 3 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,791,450 {hereinafter 'Gokcebay et al'}.

With regards to claim 3, Gokcebay et al teach:

(a) a bank of lockers 10, 20, 30 (i.e. several electronic parcel box devices) shown in Figures 1-3. The bank of lockers located at different sites and networked with each other as shown in Figures 4 through 6, each locker comprising:

at least two operating units, in the form of hubs 61, shown in Figure 6;

a plurality of electronic locks 60 (i.e. parcel boxes), several of which are associated with one of the operating units of said electronic parcel box device; and

Art Unit: 2612

a processor 63 (i.e. central control unit), the processor 63 comprising a bus driver 62 (i.e. interface);

(b) a system processor 45 (i.e. central database server) comprising database 48 (i.e. memory) for storing data about the filling status of the lockers and a transmitter for transmitting the data {see Gokcebay, column 4, lines 10-12}. In one example of having postal parcels delivered to individual electronic parcel box devices as a function of the filling status of the electronic parcel box devices 42 as claimed, the consumer contacts one of the vendors 41 through the vendor's website to order goods and have the goods delivered to one of several locker sites 42 via a delivery company 43. The goods are delivered based on the consumer's or vendor's preferences, such as locker site and/or delivery company {see Gokcebay et al, column 3, lines 11-52+}. Inherently, any one of the existing postal delivery companies in the US may be used, such as the US Post Office, UPS, FedEx, etc. The communication between the processor 45 and the locker site and individual lockers is shown in Figure {also see Gokcebay et al, paragraph-bridging columns 3 and 4}. This meets the logistic system having postal parcels delivered to individual electronic parcel box devices as a function of the filling status of the electronic parcel box devices, as claimed.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,879,243 {Booth et al} in view of US Patent 6,791,450 {Gokcebay et al}.

Claim 3 recites the limitations of claim 1 and therefore rejected on the same basis, wherein Booth et al further teach:

(a) several electronic parcel box devices networked with each other, in parallel or serial arrangement shown in Figure 7 {see Booth et al, column 9, lines 11-26}.

(b) a central database server, in the form of a SAC 22, comprising central database (i.e. memory) for storing several databases about the filling status of the lockers, shown in Tables 1-16, columns 11-16, and a transmitter for transmitting the data over different media, such as wireless technology 200 or RS 485 communication protocol;

Booth et al does not disclose, postal parcels are delivered to individual electronic parcel box devices as a function of the filling status of the electronic parcel box devices. However, Gokcebay et al, in an analogous art, teach of such claimed features in several ways through the use of locker compartments between consumers, vendors and delivery companies as shown in the diagram in Figure 4. In one example, the consumer contacts one of the vendors 41 through the vendor's website to order goods and have the goods delivered to one of several locker sites 42 via a delivery company 43. The goods are delivered based on the consumer's or vendor's preferences, such as locker site and/or delivery company {see Gokcebay et al, column 3, lines 11-52+}. Inherently, any one of the existing postal delivery companies in the US may be used, such as the US Post Office, UPS, FedEx, etc. This meets the claimed features of having postal parcels delivered to individual electronic parcel box devices 42 as a function of the filling status of the electronic parcel box devices 42. Gokcebay et al suggests that such claimed features are advantageous because it provides access to recipients of

Art Unit: 2612

deliveries and service companies and provides instant tracking of packages, pickups and deliveries {see Gokcebay et al, paragraph-bridging columns 1 and 2}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include the claimed features in the system of Booth et al because, as evidenced by Gokcebay et al, it provides access to recipients of deliveries and service companies and provides instant tracking of packages, pickups and deliveries.

Office Contact Information

11. Please note that the Examiner's supervisor has been changed.
12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Bangachon whose telephone number is **(571)-272-3065**. The Examiner can normally be reached from Monday through Friday, 9:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Brian Zimmerman can be reached on **(571)-272-3059**. The fax phone numbers for the organization where this application or proceeding is assigned is **571-273-8300** for regular and After Final formal communications. The Examiner's fax number is **(571)-273-3065** for informal communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2612


For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



William L Bangachon
Examiner
Art Unit 2635

April 23, 2007



BRIAN ZIMMERMAN
PRIMARY EXAMINER